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09/713,600	11/15/2000	Harold Kraft	61000/101	9771

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NIXON PEABODY LLP
Clinton Square
P.O. Box 31051
Rochester, NY 14603

EXAMINER

SCHRANTZ, STEPHEN D

ART UNIT PAPER NUMBER

2177

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,600

Applicant(s)

KRAFT ET AL.

Examiner

Steve Schrantz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11-15-00 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "792a" and "792b" of Figure 13A have been used to designate steps that perform the same function but occur in different conditions. "792a" occurs to object A in two different locations. "792b" occurs to object B in three different locations. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "indiscriminate data set" in claim 5 is used by the claim to mean "a data set that is extracted from the retrieved electronic records," while the accepted meaning of indiscriminate is "not making or based on careful decisions; unselective". If the data set is extracted from the retrieved electronic records, the data set is not unselective.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 13, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (U.S. Patent 5,832,494) in view of Damashek (U.S. Patent 5,418,951).

Egger teaches independent claims 1, 13, and 25 by the following:

“retrieving at least one electronic record from at least one storage location” at col. 5 lines 12-19.

The user selects a particular object on which to base the similarity between that object and the retrieved objects. At col. 3 lines 5-7, Egger teaches that the textual objects are stored in the database.

“causing the user-selectable objects to be displayed” at col. 33 lines 55-67. Egger teaches that those records that match the particular are displayed. Only those records that shared more than 4% similarity are displayed to the user. See Fig. 5E for the similar cases page that displays the 17 references that shared greater than 4% similarity with the U.S. v. Caballero case.

“parsing the electronic records to convert one or more indiscriminate data sets into user-selectable objects” at col. 5 lines 14-19. At col. 33 line 55 to col. 34 line 41, Egger further teaches that the documents are checked for similarity in both words and concepts with the first electronic record. Egger teaches the determination of the data sets but he does not actually state the word “parsed”. Damashek does teach the parsing of the data to determine the similarities with other documents in the abstract. It would have been obvious to one ordinarily skilled in the

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art at the time of the invention to parse the electronic record to determine the indiscriminate data set. By parsing the electronic record into n-grams and testing for similarity as taught at col. 5 lines 24-60, the invention is capable of document retrieval without the need for keyword or context-based information. Damashek teaches the advantage of reduction in memory requirements and increase in performance due to the n-gram technique at col. 3 lines 19-32.

As per claim 13, Egger teaches the computer processor at col. 4 lines 5-7. At col. 4 lines 5-7, Egger also teaches that the database is located remotely from the processor. The remote database stores the objects as taught at col. 1 lines 59-63.

As per claim 21, Egger teaches that the database is remote from the processor at col. 4 lines 5-7. He also teaches that the invention can work across the World Wide Web environment at col. 51 lines 24-27. Communication devices must be present in order for the invention to work across the Internet.

Egger teaches dependent claims 2, 14, and 26 by the following:

“selecting at least one of the user-selectable objects to retrieve the indiscriminate data set associated with the selected object” at col. 34 line 64 to col. 35 line 14. Egger teaches that the selectable objects from the similar-cases search can also be searched. In the example shown at col. line 64 to col. 35 line 14, the U.S. v. Nurse case is initially searched. The U.S v. Jordan case is a selectable object that is later searched to find its similar cases.

Egger teaches dependent claims 3, 15, and 27 by the following:

“wherein the indiscriminate data sets comprise court case items or documents associated with a court case docket sheet” at col. 34 lines 1-5 and col. 34 lines 16-30. Egger teaches the textual

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objects that are displayed with a cases similar search are Supreme Court cases, Court of Appeals cases, and other types of cases as taught at col. 32 lines 1-3.

Egger teaches dependent claims 4, 16, and 28 by the following:

“wherein the electronic records comprise results of an executed electronic court case records search request, at least one criterion used in formulating the electronic court case records search request and data related to at least one electronic court database associated with the electronic court case records search request” at col. 5 lines 12-18 and col. 34 lines 50-59. The similar cases search uses criterion as listed at col. 5 lines 14-18.

Egger teaches dependent claims 5, 17, and 29 by the following:

“the parsing further comprises extracting the at least one indiscriminate data set from the retrieved electronic records” at col. 25 lines 7-19 and col. 31 lines 37-47. Egger teaches that a particular reference is cited 77 times in one particular record. Fig. 5D displays the number of times a particular source is cited in the U.S. v. North record.

Egger teaches dependent claims 8, 20, and 32 by the following:

“the parsing further comprises filtering, sorting or analyzing the retrieved electronic records for data consistency” at col. 33 lines 55-59. Egger teaches that 17 hits to the search of the U.S. v. Caballero case were found. The number of hits is taught as data consistency test in the specification at page 30 lines 28-32.

6. Claims 6, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (U.S. Patent 5,832,494) in view of Damashek (U.S. Patent 5,418,951) as applied to claims above, and further in view of Hilsenrath et al. (U.S. Patent 5,926,812).

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Egger teaches the ability to search textual objects at col. 3 lines 19-26. Egger does not teach a processing algorithm based substantially on artificial intelligence. Hilsenrath does teach the use of artificial intelligence to implement the searching at col. 1 lines 29-33. Hilsenrath teaches the use of the searching for similarities between text documents at col. 1 lines 14-21 that is similar to Egger's similar case search as taught at col. 33 lines 55-67. It would have been obvious to one ordinarily skilled in the art at the time of the invention to use artificial intelligence in the parsing. Through the use of artificial intelligence, the system would use knowledge to best search the system in order to improve the search results.

7. Claims 7, 19 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (U.S. Patent 5,832,494) in view of Damashek (U.S. Patent 5,418,951) as applied to claims above, and further in view of Cohen et al. (U.S. Patent 6,356,898).

Egger teaches the searching of similar documents by topic at col. 34 lines 54-59. Egger does not teach that the parsing is based upon the content of the retrieved electronic records. Cohen does teach the parsing based upon the content at col. 7 lines 39-47. It would have been obvious to one ordinarily skilled in the art at the time of the invention to parse according to the record. By parsing according to content, the invention can break the document into topic areas as taught at col. 5 line 67 to col. 6 line 8. The topic areas can then be accessed by the users to assist them in finding relevant information as taught at col. 6 line 56 to col. 7 line 4.

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8. Claims 9-10, 21-22, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (U.S. Patent 5,832,494) in view of Damashek (U.S. Patent 5,418,951) as applied to claims above, and further in view of Spencer (U.S. Patent 5,826,261).

Egger teaches dependent claims 9, 21, and 33 by the following:

“receiving at least one electronic records search request” at col. 33 lines 55-59;

“accessing the at least one electronic records database through the first or the second communication medium based on the determination” at col. 33 lines 65-67. Egger teaches the use of a tear-off window with the similarity search. The tear off window allows access to the record as shown at col. 32 lines 11-25. Egger teaches two forms of a communication medium to access the records at col. 51 lines 24-27. Communication devices must be present in order for the invention to work across the web.

Egger does teach the use of a communication medium in both the network and the World Wide Web at col. 51 lines 24-27. Egger does not teach “determining if at least one of a plurality of electronic records databases associated with each received electronic records search request is accessible through a first or a second communication medium”. Spencer does teach the determination of the available databases for the search request at col. 18 lines 8-29. It would have been obvious to one ordinarily skilled in the art at the time of the invention to determine whether the record is accessible. Egger’s system searches the database and assumes that the records will be accessible. By determining the availability of the database, the system can ensure that the user will have access to the record stored in that database.

Egger teaches dependent claims 10, 22, and 34 by the following:

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“the plurality of electronic records databases comprises at least one first electronic court database accessible through the first communication medium and at least one second electronic court database accessible through the second communication medium” at col. 46 lines 19-46. Egger teaches that documents from multiple databases can be attached to the documents found in the system. Egger also teaches that the database consists of court cases as taught at col. 30 lines 56-65. Because the database contains court cases, it is considered an electronic court database. At col. 30 lines 56-65, Egger teaches that Supreme Court and Court of Appeals cases are textual objects. The textual objects are stored in the database as taught at col. 4 lines 5-7.

9. Claims 11, 23, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (U.S. Patent 5,832,494) in view of Damashek (U.S. Patent 5,418,951) in view of Spencer (U.S. Patent 5,826,261) as applied to claims above, and further in view of Subramaniam et al. (U.S. Patent 5,859,972).

Egger teaches the use of a court database as taught at above at col. 4 lines 5-7 and col. 30 lines 56-65. Egger does not teach accessing a database through the telephone. Subramaniam does teach the storage of court cases in databases at col. 1 lines 31-33. Subramaniam also teaches the access of the databases through both the Internet and a telephone line at col. 5 line 67 to col. 6 line 3. It would have been obvious to one ordinarily skilled in the art at the time of the invention to allow databases to be accessed through both the Internet and a telephone line. Both the Internet and telephone allow the computer to access the database. By using the communication means, the databases can be located remotely as taught by Egger at col. 4 lines 5-7.

10. Claims 12, 24, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger et al. (U.S. Patent 5,832,494) in view of Damashek (U.S. Patent 5,418,951) in view of Spencer (U.S. Patent 5,826,261) as applied to claims above, and further in view of the applicant's admitted prior art.

Egger teaches the searching of similar court cases at col. 5 lines 6-11. Egger also teaches the Cases-In subroutine that searches all of the citations in a particular case at col. 4 line 66 to col. 5 line 5. Egger does not teach that the search requests comprise court case docket sheet search requests. The specification teaches the court case docket sheet search requests at page 2 line 21 to page 3 line 8. It would have been obvious to one ordinarily skilled in the art at the time of the invention to allow the docket sheet search requests. Egger's system allows the system to perform a search on a particular court case. The system can then access all of the documents that were cited within that case as taught at col. 4 line 66 to col. 5 line 5. The docket sheet contains references to other court items or documents that are needed by the attorney. The attorney must then search the docket sheet to determine which references are needed and then obtain those references. By performing a docket sheet search request, Egger's system could then list the relevancy of each item and how many times each one was referenced within the docket sheet as taught at col. 4 line 66 to col. 5 line 5. Egger's invention would also allow the user access to the referenced documents as taught at col. 32 lines 5-22. Using Egger's system with the docket sheet would allow the user to determine which items are more relevant to the case and would then allow access to these documents. The invention would quicken searches by making the information readily available and by listing the more relevant documents.

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Conclusion


11. The prior art made of record in PTO-892 and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Schrantz whose telephone number is (703) 305-7690. The examiner can normally be reached on Mon-Fri. 8:15-4:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Steve Schrantz
February 26, 2003


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100